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Filed : December 19, 2001

### REMARKS

By this paper, no amendments have been made to the claims. Claims 1-11 remain pending and are presented for further examination.

#### I. Discussion of Objection to the Specification

In paragraph 1 of the Office Action, the Examiner objected to the title of the invention. Applicant has herein amended the title and submits that it is indicative of the invention to which the claims are directed.

#### II. Discussion of Rejection of Claims 1-11 under 35 U.S.C. 103(a)

In paragraph 3 of the Office Action, the Examiner rejected Claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Utility Model Publication No. 7-5445 [hereafter '5445]. With respect to Claim 1, the Examiner admitted that '5445 does "not show the fixing component press-welded (press-fitted) in the fixture." *O.A.* at para. 3. However, the Examiner stated that the "instant invention does not provide any reasons or specific problem to be solved by press-fitting." *Id.* Taking the position that "[p]ress-fitting is common knowledge and well known in the art of connectors in general," the Examiner argued that it "would have been obvious to one having ordinary skill in the art at the time of the instant invention to press-fit the fixing component into the fixture because this would provide a much simpler connection." *Id.* For the reasons set forth below, the Applicant respectfully disagrees with the Examiner's findings and determination that Claims 1-11 are rendered obvious by '5445.

#### A. Law of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. *See M.P.E.P. § 2143.* It is well settled that "a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'." *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris*

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*Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). The Examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fitch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). “Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

B. Invention is not rendered obvious by ‘5445

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as to Claim 1 because there is no suggestion or motivation to modify the teachings of ‘5445. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. §2143.01 (emphasis in original). As noted previously, the Examiner admitted that the ‘5445 publication does not “show the fixing component press-welded (press-fitted) in the fixture.” *O.A.* at para 3. Rather, the ‘5445 publication teaches an optical connector with two “resiliently engaging parts 33a and 34a [which] are engaged with the lower end parts of sidewalls 27 and 28 of the recessed parts 23 and 24.” ‘5445, *Abstract* (referring to figures 1 and 2). Applicant submits that the engaging parts 33a and 34a thus hold “the clamp” in position in housing chamber and prevent the optical fiber from falling from the connector. *Id.* Claim 1 recites an optical fiber fixing structure wherein “outer surfaces of the optical fiber clamping parts of said optical fiber fixing component are pressure welded with inner surfaces of the opening of said optical fiber fixture, and said coated optical fiber is fixed and prevented from falling off from said optical fiber fixture.” Thus, Applicant submits that no motivation to modify the teachings of the ‘5445 publication can be found because no additional benefit would be obtained by modifying ‘5445 to utilize the structure recited in Claim 1 to perform a function already performed by the different structure of ‘5445.

Further, if “the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the

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references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. § 2143 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Thus a rejection is improper if the suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle under which the primary reference construction was designed to operate.” *Id.* Applicant therefore submits that the rejection of Claim 1 based on the modification of ‘5455 to include the teachings of the present invention is improper because, based on the discussion above, to obtain any benefit, it would require a substantial reconstruction and redesign of the elements shown in the ‘5445 as well as a change in the basic principle of under which ‘5445 fixes the clamp to the housing.

In rejecting Claim 1, the Examiner further indicated that the “instant invention does not provide any reasons or specific problem to be solved by press fitting.” *O.A.* at para 3. However, the Applicant submits that “pressure-welding” as recited by Claim 1 does provide advantages over the prior art. For example, during assembly of a device according to the ‘5445 publication with an optical fiber, the projections 33 and 34, and in particular the protruding portion of the engaging parts 33a and 34a, make contact with the inner wall of the ferrule. This makes it difficult to insert the fixing component into the ferrule while still maintaining the proper straight alignment. In the device according to Claim 1, however, because the optical fiber fixing component can be inserted smoothly into the ferrule without interference from any protruding parts, the optical fiber fixing clamp can reliably clamp the optical fiber to the ferrule without being forced out of alignment.

C. Official Notice that “Press-fitting” is common knowledge and well known in the art.

In rejecting Claims 1-11, the Examiner took the position that “press-fitting is common knowledge and well known in the art of connectors in general.” Applicant respectfully traverses the rejection based upon the knowledge of one ordinary skill in the art. According to the Manual of Patent Examining Procedure, if an applicant traverses a rejection based upon the knowledge of ordinary skill in the art, the Examiner should cite a reference in support of his or her position. M.P.E.P. § 2144.03. Thus, Applicant respectfully requests the Examiner to provide a reference in support of this position.

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D. Examiner Fails to Establish a *prima facie* Case of Obviousness

For the reasons discussed above, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness as to Claim 1 because the Examiner has shown no motivation to combine. Therefore, Applicant submits that Claim 1 is allowable. Because Claims 2-11 each depend on Claim 1, Applicant submits that those claims are also allowable for at least the reasons discussed in connection with Claim 1.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned.

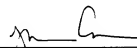
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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